

U.S. Patent Application Serial No. 09/923,963
Amendment dated September 15, 2003
Reply to OA of June 25, 2003

REMARKS

Claims 4-7 and 9-17 are pending in this application, with claims 9-17 withdrawn from consideration. Amendment has been made to claims 4-7 herein.

Restriction is required to one of the following inventions: I. Claims 4-7; II. Claims 9-17 (Office action paragraphs no. 1-5).

Applicants hereby affirm the election of Group I, claims 4-7, without traverse of the restriction requirement.

Claims 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (Office action paragraph no. 11).

The rejection is overcome by the amendments to claims 4-7.

The Examiner correctly points out that the term "substrate" in the claims should be --substance--. This is due to a typographical error in the preliminary amendment, as can be seen by the term "substance" in original claim 1. In the present amendments, "substrate" is amended to --substance--.

The Examiner also states that it is unclear how the catalytic metal or metal compound is "dotted on said layer of hydrogen-absorbing alloy oxide by adding a substance which is soluble in the electrolyte"

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In response, the claims have been amended for clarity to recite “adding a substrate substance to the negative electrode and/or the electrolyte, said substance being ~~which is~~ soluble in the electrolyte”. That is, the amendment clarifies that the substance is added to the negative electrode or the electrolyte.

Applicants note that the claims recite that the “catalytic metal or metal compound” is dotted “by adding a substance”. This recitation refers to the specification on page 3, lines 17-20, and also refers to the method disclosed in the specification on page 6, lines 12-16. The term “dotting” is also found in the disclosure on page 2, lines 17-19, of the specification, with reference to the prior art.

In response to the Examiner’s questions about how the substance would dot the layer of hydrogen-absorbing oxide, Applicants again note that the claim recites that “a catalytic metal or metal compound” is dotted. This catalytic metal or metal compound is not necessarily the same as the “substance”; the claim is a **product-by-process claim** reciting a structure **resulting from adding** the substance.

The Examiner questions how a substance soluble in the electrolyte would dot the layer of hydrogen-absorbing oxide. Applicants submit that simply because the substance is soluble in the electrolyte does not mean that there cannot be adsorption causing dotting on the hydrogen-absorbing alloy oxide layer.

Reconsideration of the rejection is therefore respectfully requested.

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Claims 4-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 6,322,925 B1 (Office action paragraph no. 13).

The rejection of claims 4-7 is respectfully traversed, and reconsideration of the rejection is respectfully requested.

U.S. Patent No. 6,322,925 is the patent resulting from U.S.S.N. 09/141140, which is the parent application for the present application. In the parent application, a restriction requirement led to cancellation of claims 4-7 and 9-17 (see Response of January 6, 2000, in the parent application), and these claims are being prosecuted in the present application.

In the preliminary amendment of August 8, 2001, claims 4-6 were rewritten in independent form, incorporating the limitations of the original base claim 1. Claim 7 has been amended only to cancel the dependence on canceled claims 1-3. The scope of claims 4-7 is therefore unchanged from that of the parent application.

Applicants note that MPEP 804 II. states: "Generally, a double patenting rejection is not permitted where the claimed subject matter is presented in a divisional application as a result of a restriction requirement made in the parent application under 35 U.S.C. 121." Applicants submit that this is the case here, and withdrawal of the rejection is respectfully requested.

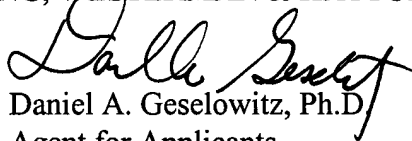
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If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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